Remarks

Applicant respectfully traverses the newly presented § 103(a) rejection because the cited combination does not correspond to the claimed invention and because the Office Action's proposed modification of the '663 reference would render the '663 reference unsatisfactory for its intended purpose.

Applicant appreciates the Examiner's withdrawal of the previous rejections. In the instant Office Action dated January 26, 2009, prosecution has been reopened, and the following new rejections are presented: claims 1-3, 5-7, 9 and 11-22 stand rejected under 35 U.S.C. § 103(a) over Ballantine (U.S. Patent No. 6,489,663) in view of Minami (U.S. Patent No. 6,730,983); and claims 4, 8 and 10 stand rejected under 35 U.S.C. § 103(a) over the '663 reference in view of the '983 reference and further in view of Kuroda (U.S. Patent No. 6,693,315). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the § 103(a) rejections of claims 1-22 because the Office Action's proposed combination does not correspond to aspects of the claimed invention directed to a plurality of tilling structures that are arranged in a geometrical pattern so as to substantially inhibit the inducement of an image current in the tilling structures by a current in an inductive element. The '663 reference does not teach that vias 28 (*i.e.,* the asserted tilling structures) are arranged to substantially inhibit the inducement of an image current in the vias 28 by a current in inductor 16 (*i.e.,* the asserted an inductive element). Instead, the '663 reference arranges the vias 28 to terminate the electric field lines emanating from inductor 16 and to decrease the parasitic capacitance present between inductor 16 and ground strips 26. *See, e.g.,* Figure 1 and Col. 5:40-45. Applicant notes that the only discussion in the '663 reference relating to preventing the flow of an image current is directed to preventing the flow of an image current in the ground strips 26 (*see, e.g.,* Col. 3:38-41, Col. 4:39-42 and Col. 6:59-62). Thus, the '663 reference does not teach or suggest arranging the vias 28 to prevent the flow of an image current in the vias 28. Applicant notes that the '983 and '315 references do not address the above discussed deficiencies of the primary '663 reference. For example, the '983 reference does not teach or suggest that dummy elements 12 are

arranged to prevent the inducement of an image current in the dummy elements 12. As such, the Office Action's proposed combination does not correspond to the claimed invention. Accordingly, the § 103(a) rejections of claims 1-22 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-22 because the Office Action's proposed modification of the '663 reference would render the '663 reference unsatisfactory for its intended purpose. *See, e.g.,* M.P.E.P. § 2143.01 and *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."). *See also KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). In this instance, the Office Action's proposed modification of the '663 reference would result in vias 28 being electrically connected to substrate 12 (*see* Figure 1 of the '663 reference) since the dummy elements 12 of the '983 reference are taught to be electrically connected to substrate 1 (*see* Figure 2 of the '983 reference). The modified vias 28 would result in high frequency-energy passing through the vias 28 into substrate 12 (as taught by the '983 reference at Col. 2:26-28), thereby increasing coupling between the substrate 12 and the inductor 16 relative to the unmodified vias 28 of the '663 reference, which are taught to be isolated from the substrate 12 (*see, e.g.,* Figure 1 and Col. 4:52-64). Thus, the Office Action's proposed modification of the '663 reference would render the '663 reference unsatisfactory for its intended purpose of preventing coupling between the substrate 12 and the inductor 16 (*e.g.,* by preventing the electric field lines generated by the inductor from penetrating into the substrate). *See, e.g.,* Col. 3:62-67. Accordingly, the '663 reference teaches away from the Office Action's proposed modification and there would be no motivation for the skilled artisan to modify the '663 reference in such a manner.

Therefore, the § 103(a) rejections of claims 1-22 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejection of claims 16-21 because the Office Action's proposed combination does not correspond to aspects of the claimed

invention directed to the device including a capacitive element. In particular, the cited portions of the '663 reference do not teach or suggest that the vias 28 (*i.e.,* the asserted tilling structures) form one electrode of the capacitive element and that the ground strips 26 (*i.e.,* the asserted ground shield) form the other electrode of the capacitive element as in claims 17 and 19. Instead, the '663 reference teaches that the vias 28 decrease the parasitic capacitance present between inductor 16 and ground strips 26. *See, e.g.,* Figure 1 and Col. 5:40-45. Moreover, the '663 reference expressly states that "In the preferred embodiment shown, the conducting vias are shown terminating between and slightly below the wires of the inductor because that is the configuration that most effectively keeps the capacitance down." Col. 4:65 to Col. 5:1. The '663 reference uses vias 28 to preventing the IC 200 from functioning as a capacitor between inductor 16 and ground strips 26. Accordingly, the § 103(a) rejection of claims 16-21 is improper and Applicant requests that it be withdrawn.

Applicant notes that claims 6 and 7 have been amended to include aspects which indicate that the geometrical pattern of tilling structures does not substantially inhibit inductive coupling between the inductive element and the substrate, or that the geometrical pattern of tilling structures does not substantially block penetration into the substrate of electric field lines generated by the inductive element. Support for these amendments can be found, for example, in paragraph 0065 of Applicant's specification. Applicant notes that the vias 28 (*i.e.,* the asserted tilling structures) of the '663 reference do terminate the electric field lines emanating from inductor 16 (*i.e.*, the vias prevent coupling between inductor 16 and substrate 12). *See, e.g.,* Figure 1 and Col. 5:40-45. As such, the vias 28 of the '663 reference do not correspond to Applicant's tilling structures.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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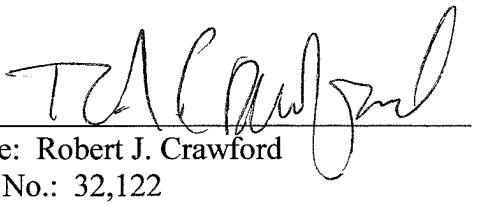
By: 
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